

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63180

Kazuhiko KUSUDA

Appln. No.: 09/783,096

Group Art Unit: 3714

Confirmation No.: 4487

Examiner: Corbett B. Coburn

Filed: February 15, 2001

For: HORSE RACING GAME WITH VARIED TRACK ATTRIBUTES

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submits the following:

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ISSUES ADDRESSED IN REPLY BRIEF

ISSUE 1 - Dependent Claims 2-4, 6, 9-11, 13, 16-18, 20 and 23-29 Merit Independent Evaluation in Groups as Presented in the Brief on Appeal

ISSUE 2 - The “Physical Passageway” Limitation of Independent Claims 1, 8, 15 Must Be Evaluated In Conjunction With The Required “Change of Inherent Parameters”

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ARGUMENT

ISSUE 1 - Dependent Claims 2-4, 6, 9-11, 13, 16-18, 20 and 23-29 Merit Independent Evaluation in Groups as Presented in the Brief on Appeal

The Examiner has taken the position that all dependent claims stand and fall with the parent independent claims. The Examiner has not separately rebutted the Appellant's position with respect to the patentability of these claims, as set forth in the Appellant's Brief on Appeal. Instead, the Examiner has simply stated that the Appellant has not argued the merits of each claim and has only pointed out the content of the rejected claims. On this basis alone, the Examiner asserts that the limitations of the dependent claims are to be ignored and that the patentability of each these claims is limited to the merits of its parent claim.

The Examiner's position is not supportable in law or fact. The Examiner's strategy, used in the face of missing support in the prior art for the limitations of the dependent claims, should not be accepted by the Board of Patent Appeals and Interferences for the following reasons.

Dependent Claims Were Argued in Distinct Groups Based on Content

The Brief on Appeal presented and argued several distinct groups of claims, including:

- (1) Group I - dependent claims 4, 11 and 18, that specify both a turf track and a dirt track in the computerized game of claims 1, 8 and 15, respectively;
- (2) Group II - dependent claims 2, 3, 9, 10, 16 and 17, that specify entire tracks where the current ability parameter of the running model is maximized or minimized in the computerized game of claims 1 (2, 3), 8 (9, 10) and 15 (16, 17);
- (3) Group III - dependent claims 6, 13 and 20, that specify concentric tracks having different attributes that exist concurrently in the computerized game of claims 1, 8 and 15;

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- (4) Group IV - dependent claim 29, that requires the tracks of claim 1 to have “variable and selectable turf or soil conditions.”
- (5) Group V – dependent claim 23, which recites a game value adding device and is argued in separate Issue II, does stand or fall with parent claim 22;
- (6) Group VI – dependent claim 28, which depends from claim 1 and specifies that the ability parameters correspond to the plurality of tracks and are based upon prior training of the physical running model on one or more of the tracks, and is argued in separate Issue II; and
- (7) Group VII – dependent claim 27, which further specifies as an additional key feature of the invention that the player may select one or more horses for his “stable”, each horse having different characteristics such as stamina, speed or normal ability, and as argued in separate Issue III.

Each claim in each group (but for Group V) defined a unique feature, which Appellant argued in the Brief on Appeal separately defined a basis for patentability over its parent claim. Appellant respectfully submits that support exists for each claim in each of Groups I-IV and VI-VII to be found patentable, even if the parent claim is not held to be patentable.

The Patentable Features of Each Dependent Claim Was Identified

The Examiner takes the position that Appellant did not argue the patentability of each dependent claim, because Appellant merely identified the content of each dependent claim. The Examiner's position misstates the substance of Appellant's argument. In each case (but for Group V), Appellant (1) identified the limitation added by the dependent claim and (2) asserted and demonstrated the absence of such limitation in the prior art. At the least, demonstrating the absence of a specific limitation from the prior art presents a basis for patentability.

Further, it is the Examiner's burden to present a *prima facie* case of obviousness. Appellant demonstrated that the features of each dependent claim is not in the prior art. The burden again is on the Examiner to demonstrate why the claimed feature is in the prior art. Similarly, the Board, in considering the patentability of each separately argued claim, should find

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a teaching or suggestion in the prior art to support the Examiner's rejection. Alternatively, the Board should overturn the Examiner's rejection of each claim separately, if no support in the teachings of the prior art is found, as Appellant has demonstrated.

Throughout The Brief on Appeal Appellant Treated Dependent Claims Separately

In addition to arguing the claims separately, under Issue I as well as Issues II and III, Appellant provided an identification of the support that exists in the specification for each claim. The overall presentation by Appellant supports a conclusion that the dependent claims must be evaluated separately and not bundled with their parent claims as a group.

Appellant respectfully refers the Board of Appeals and Patent Interferences to the content of Appellant's Brief on Appeal for the substantive support for patentability of each dependent claim.

**ISSUE 2 - The "Physical Passageway" Limitation of Independent Claims 1, 8, 15
Must Be Evaluated In Conjunction With The Required "Change of
Inherent Parameters"**

Each of independent claims 1, 8 and 15 expressly requires

"a physical passageway formed between the plurality of concurrently existing tracks so that the running model can enter and exit between the tracks, and the same running model can run in races on the plurality of tracks,

wherein said ability parameter is changed according to a movement of the running model from one of said plurality of tracks to another of said plurality of tracks through the physical passageway."

The Entire Combination of Limitations Must Be Considered

The foregoing phrases have several express limitations that, in combination, define a novel and unobvious feature of a computerized game having a plurality of concurrently existing tracks on which physical running models, having different computerized ability parameters, run a race. The combination defined by the foregoing language requires:

- (1) a physical passageway formed between the tracks so that physical running models can enter and exit each track;
- (2) the physical passage way permitting the physical running model to run races on both tracks;
- (3) the ability parameter for a running model varies for each of the plurality of tracks;
- (4) the ability parameter changes when the running model moves from one track to another track.

The Examiner's Answer identifies individual features of separate and diverse prior art references, but fails to demonstrate that the foregoing combination of four features would be obvious to one skilled in the art. It is the combination of these four features in the specified environment of a computerized game, typically in a gambling casino or similar establishment, where physical models of horses, vehicles or the like, can be seen by patrons to move on any of plural tracks that concurrently exist on a the same field. Given this environment and the assignment of inherent ability parameters to each physical running model, where the parameters determine the suitability of a physical running model to perform on a given track surface, the use of a physical passageway where running models pass and the ability parameter changes presents a significant advance.

The Examiner strains credibility by asserting that the starting line and finish line of the electronic matrix type display of Fongeallaz can be such passageway. Those two positions in Fongalez do not even bear a close resemblance to the physical passageway as claimed, and have

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no relevance to the physical movement of physical running models between tracks so that the same physical running model can run on both tracks and the inherent ability parameters of a given physical running model can change. As argued in the Brief on Appeal, any appearance of a simulated horse in Fongalez is sequential or at different times, using a single track, as illustrated in Fig. 13. The only way to have a simulated horse run on a different track in Fongalez is to reset or restart the game. There is no movement from one track to another, and no change of running ability parameters based upon such movement.

Filiczkowski has no pertinent teaching with regard to this combination of limitations. As a non-computerized and manual board game, Filiczkowski does not and would not disclose such physical features as a passageway formed between the plurality of concurrently existing tracks, or a change of ability parameters for a given running model when moving from one track to another through a passageway.

Even the more pertinent teaching of Nakagawa et al, fails to teach or suggest a passageway that provides the claimed combination of features. The pair of passageways 63a, 63b permit a horse to enter the track 5 from the paddock 6, but the passageways are not disposed “between the plurality of concurrently existing tracks” nor do they a horse to “enter and exit between the tracks.” Furthermore, keeping in mind the combination of features that are being claimed and the operational relationship between them, there is no teaching or suggestion that running parameters should change when a horse passes through the passageways 63a, 63b. Appellant’s invention is a clear advance over the features of Nakagawa et al. Moreover, nothing in Fongeallaz or Filiczkowski suggests modifying Nakagawa et al to have plural tracks that involve different running conditions, different physical running models that have running abilities that differ depending on track conditions and that change running ability parameters when moving from one track to the other through the passageway.

In short, Appellant submits that one skilled in the art having before her the board game of Filiczkowski, the matrix panel of Fongallez and the model game of Nakagawa, would not conceive of the claimed combination of features that rely upon a physical passage that permits a

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physical running model to move from one track to another track, resulting in changes in running ability parameters.

Each Independent Claim Adds Further Limitations to the Combination

While the independent claims 1, 8 and 15 share this common combination of features, they also differ in adding further limitations to the combination, thereby adding additional support to the patentability of the claims. The added features define a variation of an ability parameter for a physical running model according to the conditions of the respective tracks (e.g., dirt or turf), where the variation according to respective tracks is defined generally in claim 1 as a “current ability parameter.” Claim 8 defines the different effect of respective tracks (e.g., dirt or turf) as the provision to a running model of “variable factors of the ability parameter.” Claim 15 specifies that running models run on respective tracks based on a current ability parameter for each of plural physical running models, and further specifies that the ability parameter for each running model comprises variable factors that differ for each physical model.

The Combination of References Do Not Teach or Suggest the Invention

The Examiner states that the prior art references cannot be attacked individually. Appellant's attack is not on the references alone, but their combination. The Examiner has cited the case of *In re Keller*, 208 USPQ 871 (CCPA 1981) as supporting his position that the Appellant's arguments against the references individually are not a basis for showing unobviousness. However, the thrust of the Appellant's arguments are not against the references individually, other than to demonstrate that none teaches express claim limitations or to demonstrate features that make the references incompatible or inapplicable to one skilled in the art.. Appellant's argument is that there is no basis for their combination.

No Bases for Combining the References

At present, the controlling law with respect to the basis for combining references is defined by *Graham v. John Deere* 383 US 1 (1966) and the myriad of recent cases from the Federal Circuit that define a teaching, suggestion and motivation standard, as prominently

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defined by the decision of *In re Kahn* 441 F.3d 977 (Fed, Cir, 2006). Even as the present Reply Brief is being submitted, the Supreme Court decision in the *KSR* appeal is awaited. The standard for combining references may be clarified and even changed by that decision. Nonetheless, under any standard, there would be no basis for combining the references to teach the present invention, particularly taking into consideration the differences in implementation and the differences in applicable technology. Clearly, under the teaching, suggestion and motivation test of *In re Kahn* and its progeny in the Federal Circuit, there is:

- No teaching or suggestion of a modification of any of Filiczkowski, Fongeallaz et al or Nakagawa in such reference or the other references that would lead one skilled in the art to derive the invention as claimed, with all of its limitations. Specifically, there is no teaching or suggestion as to how or why the passageway in Nakagawa et al would be placed between tracks having different characteristics, with the ability parameters changed on the basis of a physical running model moving through the passageway, as in the claimed invention.
- No motivation to provide such passageway and a change in running ability parameters from any of Fongeallaz, Nakagawa et al or Filiczkowski provide any motivation for their combination. The theme, implementation and purpose of the different games would not lead to the game system as implemented by the inventors and as now claimed. Even if Nakagawa et al and Fongeallaz may be considered to suggest computerization of the game in Filiczkowski, the result would be a game completely different from that of the claimed invention, and there would be no basis for a passageway, as claimed.

Even if a motivation could be found, the fact that there is no teaching of the passageway and the change in running ability parameters in any reference would still support a conclusion of patentability. The Examiner's rebuttal of Appellant's arguments in the Brief on Appeal falls far short of establishing that the Appellant is not entitled to a patent on the invention as claimed. The flaws in the Examiner's position are clear, particularly with respect to the failure to teach

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express limitations and the failure to have adequate teaching, suggestion and motivation, as previously detailed in this Reply Brief and the Brief on Appeal.

Conclusion

Appellant respectfully submit that the dependent claims should be evaluated separate from the independent claims for purposes of patentability. Appellant also submits that there is no teaching or suggestion in the prior art for having a computerized running game provided with a passageway for conveying a physical running model from one concurrently existing racetrack to another, where the running model can be moved from one type of track in which the running model has a first current ability parameter to a second track where the running model's current ability parameter may have a different compatibility with the second track, where the running model runs based on a current ability parameter in accordance with the respected tracks. Thus, the use of a physical passageway in the environment defined by other limitations in the claims presents a significant feature of the game that is not taught by or even obvious from the teachings of any of the cited prior art.

Respectfully submitted,

/Alan J. Kasper/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Alan J. Kasper
Registration No. 25,426

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

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